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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,652	11/29/2001	Akitoshi Kojima	1247-0464P	2631

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EXAMINER

ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,652

Applicant(s)

KOJIMA ET AL.

Examiner

Gerardo Araque Jr.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by Murrah et al (US Patent 5,804,807).
3. In regards to **claim 14**, Murrah discloses, "... a portable data collecting terminal 50 (the "terminal") includes a bar code scanner 51, a printer 55, a magnetic card reader 56, a display 57, a keypad 58 and a communication interface port 58A. The scanner 51 is coupled to a data processor and storage device which is connected to an RF transmitter 53, which is further couple to an RF antenna (Column 5 Lines 32 – 38)."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over of Murrah et al (US Patent 5,804,807) in view Roach et al. (US Patent 5,310,997) and in further view of Garber et al (US Patent 6,232,870).

6. In regards to **claims 1 and 3**, Murrah discloses a portable terminal that is provided, which reads a tag on a commodity (Column 4 Line 21 – 23), stores the information (Column 2 Lines 24 – 28), and displays the information on a display that is found on the portable terminal (Column 2 Lines 20 – 35). Moreover, Murrah also discloses that data collection systems, such as the portable terminals disclosed by Murrah, are not only reserved to be used by the roving attendants, but by any other potential user, such as customers (Column 3 Lines 4 – 7). It would have been obvious to lend customers to use the portable terminals if enough portable terminals are provided and, of course, have them return the portable terminals when they have finished shopping.

When the customer is ready to checkout they will have their commodities ready for them at the exit counter with some type of pre-marked coding to match the commodity with the customer (Column 5 Lines 23 – 27). Moreover, all of the information that is being gathered by the portable terminal is being relayed to the central processing unit of the wireless network that is being incorporated (Column 3 Lines 29 - 35).

However, Murrah fails to teach the commodity being displayed in a display area, having the RFID tags being written to, and handing the commodities to the customer after the purchases have been made.

Roach does disclose that it is old and well known that systems incorporating the invention as disclosed by Murrah use a method of displaying a commodity in a retail area and having the customer pick up the item after purchases have been made (Roach

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Column 1 Lines 20 – 25). This method is especially useful when it comes to saving space on a retail floor. Moreover, it would be obvious to incorporate the RFID tag, as disclosed by Murrah (Column 7 Lines 63 – 67), onto the sample commodities. Furthermore, Roach discloses that once the commodity has been selected for purchase, the information would then be forwarded to the warehouse and the commodity is prepared to be picked up by the customer (Column 10 Lines 13 – 30).

However, the combination of Murrah and Roach fails to disclose that the RFID tags can be written to.

Garber teaches that those well known in the art know that RFID tags can be modified to have a wide selection of uses, such as having them being rewritable in order for them to be used multiple times (Column 5 Lines 47 – 50 and Column 7 Lines 17 – 34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Roach to modify Murrah to have sample commodity with the corresponding RFID tag on a display floor. Moreover, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Garber to allow the portable terminal to include a rewriting mechanism to the portable terminal used in the combination of Murrah and Roach so that the RFID tags can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change.

7. In regards to **claim 2**, Murrah in combination with Garber, as was previously discussed above, disclose that the information on the wireless tag is read and written by a portable terminal and that the information is then relayed to a central processing unit over a radio communication link (Column 3 Lines 55 – 63). Moreover, Murrah teaches that other coding schemes can be used, such as radio frequency identification tags, which are well known in the art to be capable of being written onto wirelessly (Column 7 Lines 63 – 67).

8. In regards to **claim 4**, Murrah is discussed above, but fails to teach a rewriting apparatus for rewriting commodity information on a wireless tag as being part of the system architecture.

Garber teaches that those well known in the art know that RFID tags can be modified to have a wide selection of uses, such as having them being rewritable in order for them to be used multiple times (Column 5 Lines 47 – 50 and Column 7 Lines 17 – 34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Garber to modify Murrah and have RFID tags that can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change. This would inherently require a rewriting apparatus or a rewriting feature to be attached to the portable terminal.

9. In regards to **claims 5 – 6**, Murrah discloses that the user, "...tallies the total on the portable data collecting terminal...(Column 4 Lines 44 – 45)"

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10. In regards to **claim 7**, Murrah discloses a portable terminal with a scanner coupled with a data processor and storage device (Column 5 Lines 35 - 36) with a printer and display in order to present the customer with commodity information (Column 5 Lines 32-35).

11. In regards to **claim 8**, Murrah discloses a portable scanner that scans the commodity information and relays it to a central processing unit because of its constant communication over a radio communication link (Column 7 Lines 40 – 46).

12. In regards to **claim 9**, Murrah discloses a central processing unit that is connected to a portable terminal through a radio communication link on a local area network that is capable of storing and creating a customer purchase record (Column 4 Lines 21 – 30).

13. In regards to **claims 10 – 13** Murrah discloses that the central process system is connected to the portable terminal wirelessly and has a display so that the customer is able to view their selection. The customer then approves of the selected commodities during the checkout process, but if the customer wants to correct the displayed selection then the attendant is able to do so (Column 6 Lines 18 – 25). This process can be done during the checkout process or from the portable terminal itself (Column 4 Lines 36 – 39). After all necessary corrections are made, the final transaction concerning payment methods can be made via a transaction on a central processing system (Column 6 Lines 34 – 47).

Response to Arguments

Claim Objections

14. Due to amendments, objections made to claim 3 have been withdrawn.

Arguments made on Page 7 – 8

15. In regards to claim 14, applicants disclose an apparatus (portable terminal) and its intended use. As a result, applicants' arguments are directed to the intended use of the apparatus. As already discussed above, Murrah et al. does indeed teach all of the elements found in claim 14.

Arguments made on Page 8 – 9

16. Applicant argues that Murrah et al. fails to teach lending out a portable terminal to customers. However, the examiner has already stated that, "It would have been obvious to lend customers to use the portable terminals if enough portable terminals are provided and, of course, have them return the portable terminals when they have finished shopping (**Page 4 Office Action written on 5/3/06**).” Moreover, the method of lending store owned equipment to customers is old and well known. For example, it is old and well known that grocery stores lend out shopping carts to customers to use during their shopping experience. Applicant also claims that Murrah et al. teaches away from lending out portable terminals because of security reasons (Murrah et al. Col. 5 L. 20 – 27). However, the examiner finds no support of this. On the contrary, Murrah et al. discloses the following on Col. 5 L. 20 – 27:

“It is preferred that the roving attendant 27 be provided with a plurality of bags to bag the merchandise at the time the items are scanned. Each bag may be uniquely identified with pre-marked codes or adhesive stickers so as to add an additional level of security. The identification of the bags for the specific

customer may also be recorded in the customer data file. This would provide secure transportation of selected items and also avoid the need to rehandle the items.”

As it can be seen, Murrah et al. does not disclose that for security reasons the portable terminals should not be handed out to customers. Therefore, applicants’ ascertainment that “...Murrah et al. appears to teach away from such a modification” (the modification regarding lending out portable terminals) is incorrect and only pertains to the merchandise purchased by the customer.

17. In conclusion, examiner finds nothing in applicants invention that has not already been taught by the combined references of Murrah et al./Roach et al./Garber et al.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

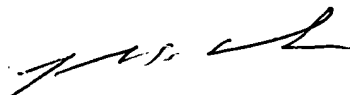
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
12/4/06



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